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In re Application of:
BADGER, David, et al. : DECISION ON PETITION TO
U.S. Application No.: 10/537,474 : WITHDRAW HOLDING OF
PCT No.: PCT/US2002/039248 : ABANDONMENT
International Filing Date: 06 December 2002 : (37 CFR 1.181)
Priority Date: None claimed :
Atty Docket No.: A35477 PCT (065855) :
For: A SYSTEM AND METHOD FOR :
INTER-RELATING MULTIPLE :
DATA TYPES : :

This decision is issued in response to the "Petition To Withdraw Holding Of Abandonment Under 37 CFR 1.181(a)" filed 24 October 2008. A petition fee is not required.

BACKGROUND

On 06 December 2002, applicants filed international application PCT/US2002/039248. The international application did not claim an earlier priority date, and it designated the United States. The deadline for submission of the basic national fee was thirty months from the international filing date, i.e., 06 June 2005.

On 03 June 2005, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 14 April 2006, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements" (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497, the surcharge for filing the oath or declaration later than thirty months after the priority date, and additional claims fees were required. However, it appears that this Form PCT/DO/EO/905 was directed to an incorrect correspondence address.

On 22 January 2008, the DO/EO/US mailed a second "Notification Of Missing Requirements" (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497, the surcharge for filing the oath or declaration later than thirty months after the priority date, and additional claims fees were required. This Form PCT/DO/EO/905 was properly directed to the above-listed correspondence address of record, and it was accompanied

by a “Withdrawal Of previously Sent Notice” vacating the improperly addressed Notification mailed 14 April 2006.

Applicants did not file a response to the Notification Of Missing Requirements mailed 22 January 2008 during the extendable response period provided in the Notification Of Missing Requirements.

On 26 September 2008, the DO/EO/US mailed a “Notice of Abandonment” (Form PCT/DO/EO/909) indicating that the application was abandoned based on applicants’ failure to file a timely response to the Notification Of Missing Requirements mailed 22 January 2008.

On 24 October 2008, applicants filed the “Petition To Withdraw Holding Of Abandonment Under 37 CFR 1.181(a)” considered herein. The petition asserts that the holding of abandonment should be withdrawn because applicants did not receive the Notification Of Missing Requirements upon which the abandonment is based.

DISCUSSION

Section 711.03(c)(I)(A) of the MPEP sets forth the requirements for a grantable petition in the present circumstances:

The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

The present petition does not include the required statements from the practitioner describing the docketing system in use at petitioner's firm and stating that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Notification Of Missing Requirements was not received.

With respect to the docket records requirement, applicants have provided a copy of what appears to be the docket record for the present application file. However, as discussed in the MPEP, what is required is a copy of the full office docket record for all responses due in the USPTO on 22 March 2008, the date on which a response to the Notification Of Missing Requirements was due.¹

Based on the above, applicants have not satisfied the requirements for a petition to confirm the failure to receive the Notification Of Missing Requirements mailed 22 January 2008. Accordingly, withdrawal of the holding of abandonment is not appropriate on the present record.

CONCLUSION

Applicants' petition under 37 CFR 1.181 is **DISMISSED** without prejudice. The application remains abandoned.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181" and must include the additional statements from the practitioner and docket records required to confirm that the Notification Of Missing Requirements mailed 22 January 2008 was not received, as discussed above and in the MPEP.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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¹ It is noted that 22 March 2008 was a Saturday. Accordingly, if applicants' docketing system dockets responses for the next business day, a copy of the full office docket for all responses due on 24 March 2008 should be provided.